

**REMARKS IN SUPPORT OF THE
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

To: Commissioner for Patents

From: Michael Smith
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Application: 10/649,419
Attorney docket: ADPS.0001
TITLE: METHOD FOR INTEGRATING DRAWINGS
AND SUPPORTING DOCUMENTS USING
GRAPHIC OBJECT INTERFACE

Inventor: David Weidner
Filing date: August 26, 2003
Art Unit: 2179
Examiner: Nicholas Augustine

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**REMARKS IN SUPPORT OF
THE PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Dear Sir:

In response to the Notice of Panel Decision from Pre-Appeal Brief Review dated Nov. 30, 2007, indicating that the request is improper because “more than 5 pages of remarks are submitted” Applicant submits shortened remarks below.

In response to the Final Office Action mailed June 20, 2007 (hereinafter, “the Final Office Action”) and further pursuant to the Notice of Appeal and Pre-Appeal Brief Request for Review submitted herewith, the Applicants respectfully request review and reconsideration of the Final Office Action in view of the following issues.

MPEP 2163.06 that states:

“If both the claims and specification contain new matter either directly or indirectly, and there has been both a rejection and objection by the examiner, the issue becomes appealable and should not be decided by petition.”

In this case, the Examiner has asserted new matter in the specification, and the Examiner objected to the asserted new matter and the Examiner has asserted rejections. Thus this patent application is ripe for appeal.

1. The objection to new matter in the specification under 35 U.S.C. 132(a) does not recognize that the added material is supported by the original disclosure.

The final Office Action dated June 20, 2007 states that:

“The added material which is not supported by the original disclosure. ...Applicant is required to cancel the new matter in the reply to this Office Action.”

Matter added from another part of the application

MPEP 2163.06 states “Stated another way, information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter.” The table below shows the source in the specification filed on August 2, 2003 for each of the amendments made on the Response dated Feb. 8, 2007:

AMENDMENT MADE ON FEB. 8, 2007	SOURCE IN SPECIFICATION FILED ON AUGUST 2, 2003
paragraph 10	page 1 lines 17-19
paragraph 11	page 2 lines 9-12
paragraph 28	FIG. 1
paragraph 30	page 2 lines 9-12
paragraph 32	FIG. 1
paragraph 34	claim 3 on page 6
paragraph 35	claim 4 on pages 6-7, claims 6-8 on page 7
paragraph 36	page 2 lines 3-5
paragraph 45	page 6 and claim 9 on page 7

In regards to the above citation of claims from the original filed application that were used to amend the specification, this practice is approved by MPEP 2163.06(III) “if an application as originally filed contains a claim disclosing material not disclosed in the remainder of the specification, the applicant may amend the specification to include the claimed subject matter. In re Benno, 768 F.2d 1340, 226 USPQ 683 (Fed. Cir. 1985).”

Well Known In the Art: The drawing of a standard computer in FIG. 10 and a written description of that standard computer in paragraphs 46-56 are not new matter, but are well known prior art. In fact, FIG. 10 is labeled “PRIOR ART.” The inclusion of this matter in the application was not necessary, but nonetheless a conventional approach to the organization of a computer-enabled invention.

Obvious Errors: MPEP2163.07(II) states “An amendment to correct an obvious error does not constitute new matter where one skilled in the art would not only recognize the existence of error in the specification, but also the appropriate correction.”

Paragraphs 12-21 of the amended specification includes amendments that are corrections of errors, the errors including capitalization of letters in the middle of sentences, multiple sentences for the description of a singular drawing, use of periods in between descriptions of drawings. The original source having obvious errors is page 2 lines 14 – page 3 line 13 of the specification filed on August 2, 2003.

Claims 10-18

In response to the assertion in the final Office Action dated June 6, 2007 that “original disclosure does not cover the amended claims 1-9” and “that the amended claims now direct themselves to rely on the new specification rendering them to be new matter” Applicant provides a listing below of claims 10-18 that includes explicit cites to the specification of the Application filed on August 26, 2003.

Claim 10. (page 6 lines 3 and 10-12), (page 5 lines 10-11) (page 3 lines 19-20) (page 8 line 13).

Claim 11. (page 6 lines 9-15).

Claim 12. (page 6 lines 9-20).
Claim 13. (page 6 line 21 – page 7 line 2).
Claim 14. (page 7 lines 3-6).
Claim 15. (page 5 lines 10-11) (page 7 lines 7-10).
Claim 16. (page 6 lines 10-11) (page 7 lines 11-12).
Claim 17. (page 5 lines 10-11) (page 7 lines 13-15).
Claim 18. (page 6 lines 3 and 9-11) (page 7 lines 16-19).

2. The rejection of claim 10-18 under 35 U.S.C. 102(a) does not recognize that the added material is supported by the original disclosure.

This rejection is predicated upon the assertion that claims 10-18 contain new matter. As discussed above, the application contains no new matter. Therefore, Applicant requests that the Office withdraw the 35 USC 112 rejection.

3. The rejection of claims 10-18 under 35 U.S.C. 102(b) are missing at least one element for each claim.

The final Office Action dated June 20, 2007 rejected claims 10-18 under 35 U.S.C. 102(b) as being anticipated by Microsoft (Internet Explorer Version 6.0.2800.1 1 06.xpspl.020828-1920CO).

Claims 10 and 18. Independent claims 10 and 18 require a “construction industry project item” and “construction, repair or maintenance of at least one construction project item.” “Construction industry” is not disclosed in the reference of Microsoft Internet Explorer, therefore, claims 10 and 18 are novel over the Microsoft Internet Explorer reference. Moreover, Microsoft Internet Explorer is a “horizontal” application in which the application does not have an implementation to any particular specific vertical industry, such as “construction.” Accordingly, Microsoft Internet Explorer would not be

configured, designed or modified to accommodate in any particular manner “construction industry.”

Claim 12. claim 12 requires “a computer based project representation represented using a licensed and proprietary computer based platform.” However, the Microsoft Internet Explorer reference does not disclose any such “licensed and proprietary computer based platform.”

Thus the cited reference fails to disclose or suggest at least two elements of claims 10 and 18. Therefore claims 10 and 18 are allowable over the cited reference. Claims 11-17 depend directly or indirectly from claim 10, and are therefore allowable at least by virtue of their dependence from allowable claim 10. Thus, applicant respectfully requests withdrawal of the 35 USC 102(b) rejection.

CONCLUSION

Applicant respectfully requests reconsideration and withdrawal of each of the objections and rejections.

Respectfully Submitted,



Dated: February 24, 2008

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